

REMARKS

This Amendment is submitted simultaneously with filing of the request for continuing examination.

With the present Amendment applicants have amended claim 11, the broadest claim on file, and also added additional claims 24 and 25.

It is respectfully submitted that the hand power tool in accordance with the present invention is not disclosed in the prior art and can not be derived from it as a matter of obviousness.

Claim 1, the broadest claim on file, defines a hand power tool in which the handle includes the following separate elements:

1. A gripping part,
2. An additional mounting part,
3. An additional elastic, vibration damping element,
4. An additional movable safety element.

The patent to Radle applied by the Examiner against the original claims discloses Radle discloses a device that has a main handle 28 which includes the following elements:

1. A gripping part 34, 36 (two halves of the gripping part),
2. No additional mounting part,
3. Elastomeric sleeves 56,
4. A bolt and nut combination 56.

In the Examiner's opinion, in the patent to Radle the lower joint 32 serves as a mounting part. This is however not correct since the lower joint 32 is formed by four elements enumerated above, which contradicts the additional mounting part. In the patent to Radle the joint includes the gripping part and is not additional of the gripping part. No other element disclosed in the patent to Radle as being part of the handle may serve as a mounting part as defined in claim 11.

The Examiner indicated that the previously used expressions "separate" were given the broadest reasonable interpretation and cites the American Heritage Dictionary "separate" as a verb. It is respectfully submitted that "separate" was used as an adjective and not as a verb. It is

therefore believed that the Examiner's broad interpretation is not justifiable. However, in order to avoid any discussion, the claim has been amended to define the term "additional" which does not give rise to such broad interpretation.

The patent to Radle does not disclose any safety element. The Examiner used the bolt and nut combination 52 as a safety element, which ignores that this is clearly is no safety element. Its purpose is to "hold the lower joint 32" together, as explained in column 5, line 1. The safety element is an element for safety purposes, such element is redundant in normal operation and gives safety in abnormal processes. Any element which is necessary for normal operation is not a safety element. The bolt and nut combination 52 is clearly necessary for normal operation of the power tool, since it holds the two halves 34, 36 together which, without the bolt and nut combination, would fall apart during any operation. Therefore, the bolt and nut combination 52 can not be considered as a safety element. Thus, the patent to Radle does not show any safety elements.

The Examiner further argued that the bolt and nut combination 52 disclosed in the patent to Radle is a safety element, since it would create an unsafe condition for the user if it would break or fail. In the applicant's

opinion this is an unacceptable interpretation which can not be utilized. With such interpretation almost any element of the hand tool machine could be considered as being a safety element. A safety element does not cause damage upon its breakage. A safety element prevents damage in case of an accident.

Furthermore, the Examiner indicated that the bolt and nut combination 52 in the patent to Radle is used in the capacity as the same invention. This however is a clear misinterpretation of the present invention. The claimed safety element prevents damage in case of an accident. The bolt and nut combination 52 in the patent to Radle causes damage upon breakage. In contrast to this, the safety element of the present invention is redundant. Nothing would happen if it would eventually break.

The third difference of the amended claim 1 over the patent to Radle is the mobility of the safety element. The safety element "during a predetermined operation" being movable relative to said gripping part". The bolt and nut combination 52 disclosed in the patent to Radle is truly fixed to the gripping element a during predetermined operation and is not movable as claimed. During a predetermined operation nothing of the bolt and nut combination 52 is movable relative to the gripping part.

The Examiner further argued that the bolt and nut combination is movable since it is surrounded by elastomeric sleeves 56 which would provide for some inherent movement for nut and bolt combination 52. This is true of course. However, the Examiner in the applicant's opinion did not properly read claim 11 which states that the safety element is movable relative to said gripping part. In the patent to Radle the nut and bolt combination 56 directly contacts the gripping part and is therefore not movable relative to the gripping part. The thusly amended sleeves only allow movement relative to the housing 18.

It is therefore believed that the new features of the present invention which are defined in claim 11 are not disclosed in the patent to Ratley, and therefore claim 1 should be considered as patentably distinguishing the present invention from the solution proposed in the patent to Ratley.

Claim 11 was rejected by the Examiner over the patent to Jares in view of the patents to Weber and Minamidate . Applicants have to respectfully disagree with the position of the Examiner expressed in this rejection. It is respectfully submitted that a safety element which is "movable

relative to said gripping part to avoid the passage of vibrations through the safety element", is not disclosed in any of these references.

In the Examiner's opinion the patent to Minamidate shows this feature in Figure 1. Applicants agree that Figure 1 shows a rod 3 which is movable as such. However, the rod is not movable to avoid a passage of vibrations through it. In the patent to Minamidate it is clearly stated that the rod is provided for transmitting vibrations (page 2, line 1, lines 35-44). The whole mechanism disclosed in the patent to Minamidate does only work if the tie rod 3 transmits vibrations, as was explained in the previous Amendment.

The feature in the applicant's invention "to avoid the passage of vibrations through the safety element" is exceptionally important, and it clearly distinguishes the present invention from the prior art.

Claims 20-23 were rejected by the Examiner as anticipated by the patent to Radle. The rejection of these claims is believed to be unjustified.

With respect to claim 20, the Examiner indicated that the safety element in the patent to Radle is connected to said gripping part exclusively via said elastic element. This is clearly not so. In the patent to Radle the bolt and nut combination 52, apart from not being any safety element is directly connected to the gripping part and not via the elastomeric sleeves 56.

With respect to claim 21 the Examiner maintained that the safety element in the patent to Radle is completely surrounded by the elastic element. In Figure 2 of the patent to Radle it is clearly shown that the bolt and nut combination 52 is not completely surrounded by the elastomeric sleeves 56, but only some sections. The upper and lower ends of the bolt and nut combination 52 for example are free as well as the middle section.

The same is true with respect to claim 22. The patent to Radle does not disclose any distance as defined in this claim, filled with elastic material.

Claim 23 together with amended claim 1 also distinguishes the present invention from the patent to Radle, since both the gripping part and the separate mounting part show discs, which is not the case in the patent

to Ratley. These claims should also be considered as patentably distinguishing over the art and should be allowed.

The Examiner applied the rejection under 35 U.S.C. 102. In connection with this rejection, applicants wish to cite this the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely the references applied by the Examiner did not disclose each and every element of the present invention as defined in claim 11. It is therefore believed that the anticipation rejection should be considered as no longer tenable and should be withdrawn.

As for the obviousness rejection, it was explained in detail that the present invention can not be considered as obvious from the references, since the references do not have any hint or suggestion that the new features of the present invention can be provided in the references. In order to arrive at the applicant's invention from the teachings of the references, the references have to be fundamentally modified. It is known that in order to

arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is completely clear that the references do not provide any hint or suggestion for such modifications.

In view of the above presented remarks and amendments, the claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in

formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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